

REMARKS/ARGUMENTS

II. PRIOR ART MATTERS.

- A. The Office Action rejected claims 1, 4, and 8 under 35 USC 102(ae as being anticipated by Slemker Applicant respectfully traverses this rejection.

A single prior art reference anticipates a claimed invention only if it discloses each and every claim element.¹

Slemker does not disclose: a valveless plate/socket attachment for connecting the vacuum source to the socket cavity. Applicant discussed Slemker at page 22, last paragraph and distinctly pointed out that all embodiments of Slemker require some sort of valve associated with the plate. Applicant's invention involves a valveless plate/socket attachment.

Claim 1 is therefore allowable.

Claims 4 and 8 contain additional elements or limitations beyond allowable claim 1 and are also allowable.

- B. The Office Action rejected claims 9 and 10 under 35 USC 103(a) as being unpatentable over Slemker. Applicant respectfully traverses the rejection.

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.² If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of non-obviousness.³

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claimed combination and the reasonable

¹ *Structural Rubber Prod. Co. v. Park Rubber Co.*, 749 F.2d 707, 223 USPQ 1264 (Fed. Cir. 1984)

² MPEP Sec. 2142.

³ *Id.*

expectation of success must both be found in the prior art, and not based on applicant's disclosure.⁴

Applicant respectfully traverses the § 103 rejection because the office action has not established a *prima facie* case of obviousness.

The reference does not teach or suggest all the claim limitations, as discussed above in regard to claim 1.

Claims 9 and 10 contain additional elements or limitations beyond allowable claim 1 and are also allowable.

In addition, the Examiner is taking Official Notice that:

Regarding claim 10, a weight-actuated vacuum pump was well known and would have been obvious in order to avoid the need for external power altogether....

This is impermissible. As noted above, the prior art “must teach or suggest all the claim limitations.” The Examiner has not shown where the prior art teaches or suggests a weight-actuated vacuum pump.

Finally, the Examiner has not applied the test of *Graham v. John Deere Co.*⁵ The MPEP requires the Examiner to do so.⁶ However, the Examiner has made no finding of the level of ordinary skill in the art.⁷

C. The Office Action rejected claim 7 under 35 USC 103(a) as being unpatentable over Slemker in view of Fishman. Applicant respectfully traverses the rejection.

Claim 7 contains additional elements or limitations beyond allowable claim 1 and is also allowable.

D. The Office Action rejected claims 3, 5, 6, and 11 under 35 USC 103(a) as being unpatentable over Slemker in view of Caspers. Applicant respectfully traverses the rejection.

⁴Id. (emphasis supplied)

⁵ 383 U.S. 1 (1966)

⁶ MPEP § 2141

⁷ MPEP § 2141.03

Claims 3, 5, 6, and 11 contain additional elements or limitations beyond allowable claim 1 and are also allowable.

- E. The Office Action objected to claims 2 and 12 as being dependent upon a rejected base claim.

Claims 2 and 12 contain additional elements or limitations beyond allowable claim 1 and are also allowable.

- F. The Office Action indicated that claim 13 would be allowable if rewritten to overcome the rejection under 35 USC 12, second paragraph and to include the limitations of the base claim and any intervening claims. Applicant respectfully traverses the rejection.

Claim 13 has been amended to overcome the 35 USC 112, second paragraph rejection. Claim 13 contains additional elements or limitations beyond allowable claim 1 and is also allowable.

Applicant thanks the Examiner for indicating that claims 14 and 15 are allowable.

The Office Action stated that Applicant's remarks had been reviewed (from the Amendment and Response filed June 23, 2003). The Examiner maintains his position that Slemker discloses a valveless plate/socket attachment because the Examiner interprets element 58 as not part of the plate/socket attachment.

Further Argument

With respect, Applicant believes that the Examiner's interpretation is incorrect, for the following reasons:

1) BACKGROUND: Slemker states that "The present invention relates generally to prosthetic devices and, more particularly, to a valve assembly for use with a prosthetic limb socket." (emphasis supplied)

2) SUMMARY OF THE INVENTION:

"The present invention is a valve assembly for a prosthetic limb which responds to the problems associated with the prior prosthetic limb devices and valve systems. More particularly, the present invention provides a cylindrical or hemispherical valve plate for insertion into the distal end of a prosthetic limb socket." (emphasis supplied) (Col. 3 lines 1-10)

“In accordance with the present invention, the valve assembly includes a base which is fitted within the distal end of the socket. The base includes a chamber therewithin and an channel extending through the proximate surface of the base for providing fluid communication between the chamber and the interior of the socket. The valve assembly also includes a duct extending through the socket engaged with the base, which is in fluid communication with the chamber. A valve is coupled to the duct outside the socket and an air tight seal is provided between the base and the socket so that a suction fit can be achieved as described below.” (Col. 3 lines 11-21)(emphasis supplied)

3) DETAILED DESCRIPTION:

“A valve 58 having a valve duct 60 extends through the socket 12 and is engaged with the base plate 16 such that the duct 60 is in fluid communication with the base plate chamber 20. The valve duct 60 extends through the passage 66 in the interface cushion and an air-tight seal 68 is provided to seal the duct from the socket.” (Col. 5 lines 14-19) (emphasis supplied)

4) CLAIMS:

“1....a valve assembly including...a valve extending through the socket and coupled to the base for controlling the flow of air from the socket interior and through the channel.” (Col. 11 lines 10-30) (emphasis supplied)

In summary, there is absolutely no disclosure in Slemker of a valveless plate/socket attachment as Applicant claims. The above citations from Slemker clearly show that Slemker discloses only a valve assembly, not a valveless plate/socket attachment.

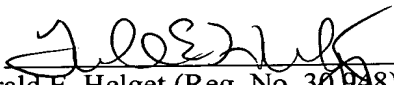
More specifically, the Examiner is directed to Fig. 21 of the present patent application, in which the valve 78 is shown external to and separate from the plate/socket attachment 200. In contrast, Fig. 1 of Slemker shows the valve 58 generally indicated by curved arrow 58, which includes valve duct 60 that extends through the socket 12 and the interface cushion 28.

The Examiner also states that the valve 58 is “clearly releasable from the base plate 16, since otherwise the valve plate assembly 10 would not be ‘releasably attached to the socket extension 38’”. This logic is incorrect, as the patent identifies the “valve plate assembly” 10 as including the valve 58. Therefore, the valve plate assembly (including the valve) must be releasably attached to the socket extension.

For the above reasons, Applicant respectfully requests the allowance of all claims and the issuance of a Notice of Allowance.

Respectfully submitted,

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